

J. SCOTT GERIEN, State Bar No. 184728
 JOHN N. HEFFNER, State Bar No. 221557
 DICKENSON, PEATMAN & FOGARTY
 1455 First Street, Ste. 301
 Napa, California 94559
 Telephone: (707) 252-7122
 Facsimile: (707) 255-6876

Attorneys for Defendants & Counterclaimants
 DUCK COMMANDER, INC. AND
 SUTTER HOME WINERY, INC.

UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA

Duckhorn Wine Company, a California
 Corporation,

Plaintiff,

v.

Sutter Home Winery, Inc., d/b/a Trinchero
 Family Estates, Duck Commander, Inc.,
 and Wal-Mart Stores Inc.,

Defendants.

CASE NO. 13-05525 EDL

**ANSWER AND COUNTERCLAIM FOR
 DECLARATORY RELIEF**

DEMAND FOR JURY TRIAL

Duckhorn Wine Company, a California
 Corporation,

Plaintiff & Counterdefendant,

v.

Sutter Home Winery, Inc., d/b/a Trinchero
 Family Estates, Duck Commander, Inc.,
 and Wal-Mart Stores Inc.,

Defendants & Counterclaimants.

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ANSWER AND COUNTERCLAIM
 FOR DECLARATORY RELIEF

CASE NO. 13-05525 EDL

ANSWER

Defendants and Counterclaimants, Duck Commander, Inc. (“DCI”) and Sutter Home Winery, Inc (“SHW”) (collectively “Defendants”), for their Answer to the Complaint filed by Plaintiff and Counterdefendant, Duckhorn Wine Company (“Plaintiff”), allege as follows:

1. Defendants are without sufficient information and knowledge as to Duckhorn’s motivation in initiating the action and on such basis deny that Duckhorn is seeking to protect its trademarks in bringing the lawsuit. Defendants further deny all of the remaining allegations in Paragraph 1 of the Complaint.
2. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 2 of the Complaint and on such basis deny such allegations.
3. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 3 of the Complaint and on such basis deny such allegations.
4. Defendants admit that they use, either directly or through licensing, the mark DUCK COMMANDER and images of ducks on and in association with wine. Defendants deny all of the remaining allegations in Paragraph 4 of the Complaint.
5. SHW admits that it was contacted on or about October 1, 2013 by Duckhorn requesting a meeting concerning the DUCK COMMANDER mark. DCI admits to the occurrence of such contact based on representations made to DCI by SHW. Defendants deny all of the remaining allegations in Paragraph 5 of the Complaint.
6. SHW admits that it met with Duckhorn in early November 2013 at SHW’s offices, that Duckhorn made several proposals to SHW to settle the dispute, and that SHW made no settlement proposals of its own. DCI also admits to the occurrence of such same events admitted by SHW based on representations made to DCI by SHW. Defendants deny all of the remaining allegations in Paragraph 6 of the Complaint.
7. Denied.
8. Defendants deny the first sentence of Paragraph 8 of the Complaint. Defendants are without sufficient information and knowledge as to Duckhorn’s hopes and on such

1 basis deny the allegations contained in the second sentence of Paragraph 8 of the
2 Complaint. Exhibit A attached to the Complaint speaks for itself.

3 9. Defendants admit to the allegations contained in the first sentence of Paragraph 9 of the
4 Complaint and to the authenticity of Exhibit B attached to the Complaint. Defendants
5 deny the third and fourth sentences of Paragraph 9 of the Complaint. Defendants are
6 without sufficient information and knowledge as to the allegations contained in the fifth
7 and sixth sentences of Paragraph 9 of the Complaint and on such basis deny such
8 allegations. Exhibit C attached to the Complaint speaks for itself. Defendants deny the
9 eighth and ninth sentences of Paragraph 9 of the Complaint.

10 10. Defendants are without sufficient information and knowledge as to the allegations
11 contained in Paragraph 10 of the Complaint and on such basis deny such allegations.

12 11. SHW admits that it a California corporation and its principal place of business address
13 as alleged, and DCI also admits to such facts based on SHW's representation.
14 Defendants deny all remaining allegations in Paragraph 11 of the Complaint.

15 12. DCI denies the allegations contained in the fourth, fifth and sixth sentences of
16 Paragraph 12 of the Complaint and admits the remaining allegations in Paragraph 12.
17 SHW makes such same denial and admissions based on the representations made by
18 DCI.

19 13. DCI admits that it licenses, markets, promotes and sells a wide manner of products
20 using the DUCK COMMANDER name and mark and that it has embarked on a plan to
21 license the DUCK COMMANDER mark for use on wine to be sold at retail stores
22 throughout the country, including Walmart stores, and DCI otherwise denies the
23 allegations contained in the first sentence of Paragraph 13 of the Complaint. DCI
24 admits the second sentence of Paragraph 13 of the Complaint. SHW makes such same
25 denial and admissions based on the representations made by DCI.

26 14. Defendants are without sufficient information and knowledge as to the allegations
27 contained in Paragraph 14 of the Complaint and on such basis deny such allegations.

1 15. Denied.

2 16. Admitted.

3 17. Defendants admit that the DUCK COMMANDER mark and a duck design are used by
4 Defendants, either directly or through licensing, on and in association with wine in the
5 State of California and within this judicial district.

6 18. Defendants admit that they have transacted business in the State of California and
7 within this judicial district and SHW admits that it resides in this judicial district and
8 Defendants expected their acts to have consequence in the State of California and
9 within this judicial district.

10 19. Defendants admit that venue is proper. Defendants deny the remaining allegations of
11 Paragraph 19 of the Complaint.

12 20. Defendants are without sufficient information and knowledge as to the allegations
13 contained in Paragraph 20 of the Complaint and on such basis deny such allegations.

14 21. Defendants are without sufficient information and knowledge as to the allegations
15 contained in Paragraph 21 of the Complaint and on such basis deny such allegations.

16 22. Defendants are without sufficient information and knowledge as to the allegations
17 contained in Paragraph 22 of the Complaint and on such basis deny such allegations.

18 23. Defendants are without sufficient information and knowledge as to the allegations
19 contained in Paragraph 23 of the Complaint and on such basis deny such allegations.

20 24. Defendants are without sufficient information and knowledge as to the allegations
21 contained in Paragraph 24 of the Complaint and on such basis deny such allegations.

22 25. Defendants are without sufficient information and knowledge as to the allegations
23 contained in Paragraph 25 of the Complaint and on such basis deny such allegations.

24 26. Defendants are without sufficient information and knowledge as to the allegations
25 contained in Paragraph 26 of the Complaint and on such basis deny such allegations.

26 27. Defendants are without sufficient information and knowledge as to the allegations
27 contained in Paragraph 27 of the Complaint and on such basis deny such allegations.

28. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 28 of the Complaint and on such basis deny such allegations.

29. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 29 of the Complaint and on such basis deny such allegations.

30. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 30 of the Complaint and on such basis deny such allegations.

31. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 31 of the Complaint and on such basis deny such allegations.

32. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 32 of the Complaint and on such basis deny such allegations.

33. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 33 of the Complaint and on such basis deny such allegations.

34. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 34 of the Complaint and on such basis deny such allegations.

35. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 35 of the Complaint and on such basis deny such allegations.

36. Denied.

37. Admitted.

38. Admitted.

39. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 39 of the Complaint and on such basis deny such allegations.

40. Admitted.

41. Admitted.

42. Denied.

43. Denied.

44. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 44 of the Complaint and on such basis deny such allegations.

1 45. Denied.

2 46. Admitted.

3 47. Defendants admit that they were aware of Duckhorn's registered trademarks
4 encompassing the term DUCKHORN when they began using, either directly or through
5 a license, the DUCK COMMANDER trademark on and in association with wine which
6 includes different wine varieties under the sub-brands TRIPLE THREAT RED
7 BLEND, WOOD DUCK CHARDONNAY and MISS PRISS PINK MOSCATO, that
8 SHW's web site advertises these wines, that Defendants hosted a November 19, 2013
9 launch party for the DUCK COMMANDER wines and that DUCK COMMANDER
10 wines have sold and continue to be sold in Walmart locations. Defendants admit that
11 Exhibits L, M and N attached to the Complaint reflect the wine labels for the DUCK
12 COMMANDER wine. Defendants deny the remaining allegations contained in
13 Paragraph 47 of the Complaint.

14 48. Denied. The search results attached as Exhibit D to the Complaint appear to represent
15 advertising which, upon information and belief, would have been purchased and placed
16 by Duckhorn.

17 49. Denied. The search results attached as Exhibit E to the Complaint appear to represent
18 advertising which, upon information and belief, would have been purchased and placed
19 by Duckhorn.

20 50. Admitted.

21 51. Defendants admit that they continue to use, either directly or by license, the mark
22 DUCK COMMANDER on and in association with wine. Defendants deny the
23 remaining allegations contained in Paragraph 51 of the Complaint.

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FIRST CAUSE OF ACTION
(Trademark Infringement, 15 U.S.C. § 1114)

52. Defendants hereby incorporate and re-allege their answers to Paragraphs 1 through 51 of the Complaint as though fully set forth herein.

53. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 53 of the Complaint and on such basis deny such allegations.

54. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 54 of the Complaint and on such basis deny such allegations.

55. Admitted.

56. Defendants admit that they were aware of Duckhorn's registered trademarks encompassing the term DUCKHORN when they began using, either directly or through a license, the DUCK COMMANDER trademark on and in association with wine. Defendants deny the remaining allegations in Paragraph 56 of the Complaint.

57. Denied.

58. Denied.

59. Denied.

60. Defendants admit that Duckhorn has requested they cease use of the DUCK COMMANDER mark on and in association with wine but that Defendants have refused to cease use. Defendants deny the remaining allegations in Paragraph 56 of the Complaint.

61. Denied.

SECOND CAUSE OF ACTION
(Trademark Dilution, 15 U.S.C. § 1125)

62. Defendants hereby incorporate and re-allege their answers to Paragraphs 1 through 61 of the Complaint as though fully set forth herein.

63. Denied.

64. Denied.

65. Defendants admit that their use of DUCK COMMANDER and images of ducks on and in association with wine came after Duckhorn first used its trademarks encompassing the term DUCKHORN. Defendants deny the remaining allegations in Paragraph 65 of the Complaint.

66. Denied.

67. Denied.

68. Denied.

THIRD CAUSE OF ACTION
(Trademark Infringement, Bus. & Prof. Code §14245)

69. Defendants hereby incorporate and re-allege their answers to Paragraphs 1 through 68 of the Complaint as though fully set forth herein.

70. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 70 of the Complaint and on such basis deny such allegations.

71. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 71 of the Complaint and on such basis deny such allegations.

72. Admitted.

73. Defendants are without sufficient information and knowledge as to the allegation as to Duckhorn's rights in a California trademark registration for DUCKHORN and on such basis deny such allegation. Defendants admit that if such registration was valid and in force, they would have had constructive knowledge of such California trademark registration when they began using, either directly or through a license, the DUCK COMMANDER trademark on and in association with wine. Defendants deny the remaining allegations in Paragraph 73 of the Complaint.

74. Denied.

75. Denied.

76. Denied.

77. Defendants admit that Duckhorn has requested they cease use of the DUCK COMMANDER mark on and in association with wine but that Defendants have refused to cease use. Defendants deny the remaining allegations in Paragraph 77 of the Complaint.

78. Denied.

FOURTH CAUSE OF ACTION
(Trademark Dilution, Bus. & Prof. Code § 14247)

79. Defendants hereby incorporate and re-allege their answers to Paragraphs 1 through 78 of the Complaint as though fully set forth herein.

80. Denied.

81. Denied.

82. Defendants admit that their use of DUCK COMMANDER and images of ducks on and in association with wine came after Duckhorn first used its trademarks encompassing the term DUCKHORN. Defendants deny the remaining allegations in Paragraph 82 of the Complaint.

83. Denied.

84. Denied.

85. Denied.

FIFTH CAUSE OF ACTION
(Common Law Trademark Infringement)

86. Defendants hereby incorporate and re-allege their answers to Paragraphs 1 through 85 of the Complaint as though fully set forth herein.

87. Defendants are without sufficient information and knowledge as to the allegations contained in Paragraph 87 of the Complaint and on such basis deny such allegations.

1 88. Denied.

2 89. Denied.

3 90. Denied.

4 91. Defendants admit that Duckhorn has requested they cease use of the DUCK
5 COMMANDER mark on and in association with wine but that Defendants have refused
6 to cease use. Defendants deny the remaining allegations in Paragraph 91 of the
7 Complaint.

8 92. Denied.

9
10 **SIXTH CAUSE OF ACTION**
11 **(Unfair Competition Law, Bus. & Prof. Code §17200)**

12 93. Defendants hereby incorporate and re-allege their answers to Paragraphs 1 through 92
13 of the Complaint as though fully set forth herein.

14 94. Denied.

15 95. Denied.

16 96. Denied.

17 97. Denied.

18 98. Denied.

19
20 **PRAYER FOR RELIEF**

21 Wherefore, Defendants request that all of Plaintiff's claims and the relief requested be
22 denied in their entirety and that judgment be entered in favor of Defendants.

23 This constitutes an exceptional case such that Defendants should be awarded their
24 attorneys' fees pursuant to 15 U.S.C. § 1117(a). Defendants further request that they be
25 awarded their costs and expenses.

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DEFENDANTS' COUNTERCLAIM

Defendants and Counterclaimants, Duck Commander, Inc. ("DCI") and Sutter Home Winery, Inc ("SHW") (collectively "Counterclaimants"), for their complaint against Plaintiff and Counterdefendant, Duckhorn Wine Company ("Counterdefendant"), allege as follows:

NATURE OF ACTION

1. This is an action for declaratory relief under the Declaratory Judgment Act seeking a declaration of the Court that Counterclaimants have not infringed and/or violated any rights of Counterdefendant under the Lanham Act by virtue of Counterclaimants' use of the trademark DUCK COMMANDER on wine.

THE PARTIES

2. Counterclaimant Duck Commander, Inc. is a Louisiana corporation with its principal place of business located at 117 Kings Lane, West Monroe, Louisiana 71292
3. Counterclaimant Sutter Home Winery, Inc. is a California corporation with its principal place of business located at 100 St. Helena Highway South, St. Helena, California 94574.
4. Upon information and belief, Counterdefendant Duckhorn Wine Company is a California corporation with its principal place of business located at 1000 Lodi Lane, St. Helena, California 94574.

JURISDICTION AND VENUE

5. This Court has subject matter jurisdiction over Counterclaimants' claim under and pursuant to 28 U.S.C. §2201, as the Counterdefendant's coercive action as set forth in greater detail below necessarily presents a federal question under the federal Lanham Act, 15 U.S.C. §1125.

- 1 6. Upon information and belief, Counterdefendant's principal place of business is located
2 within this judicial district, and Counterdefendant, either directly or through its agents,
3 transacted business in the State of California and within this judicial district, as more
4 specifically set forth below, and expected or should reasonably have expected its acts to
5 have consequence in the State of California and within this judicial district.
- 6 7. Venue is proper in this district pursuant to 28 U.S.C. §1391(b), as Counterdefendant's
7 principal place of business is located in this judicial district, and Counterdefendant is
8 doing business in this judicial district and therefore may be found in this district, and/or
9 as a substantial part of the events giving rise to the claims alleged herein occurred in
10 this judicial district, and/or the asserted infringement occurred in this judicial district.
- 11 8. As declaratory relief is being sought in relation to claims of trademark infringement, an
12 intellectual property claim, this action may be assigned on a district-wide basis.

13
14 **ALLEGATIONS COMMON TO ALL CLAIMS**

- 15 9. DCI is a family business started in 1973 by Phil Robertson, patriarch of the Robertson
16 family of West Monroe, Louisiana. In 1978, Phil Robertson first made commercial use
17 of the trademark DUCK COMMANDER in association with duck call devices used for
18 hunting. The DUCK COMMANDER mark is now owned by DCI and is the subject of
19 U.S. Trademark Registration No. 1,722,152 issued in 1992.
- 20 10. Over the years since its founding, DUCK COMMANDER became a multi-million
21 dollar brand with DUCK COMMANDER duck calls and other duck hunting gear being
22 sold in large retail stores and large outdoor stores throughout the United States.
- 23 11. Part of the popularity of the DUCK COMMANDER brand is also directly attributable
24 to Phil Robertson, his brother, and his sons. The Robertson men represent honest
25 family values and are known for their distinctive long beards.
- 26 12. The personalities of the Robertson men were first uniquely associated with the DUCK
27 COMMANDER brand as early as the 1980s when the company produced and sold
28

1 DUCK COMMANDER videos featuring Phil Robertson and his duck-hunting
2 adventures. As a result of such videos Phil Robertson became a celebrity in the hunting
3 world.

4 13. In 2009, the Robertsons and the DUCK COMMANDER brand made their transition
5 into television appearing in the television series *Benelli Presents Duck Commander*
6 which aired on the Outdoor Channel for three seasons.

7 14. Following the *Benelli Presents Duck Commander* series on the Outdoor Channel, the
8 Robertsons and the DUCK COMMANDER brand made the transition to A&E in 2012
9 where they starred on the new series *Duck Dynasty* which follows the day-to-day lives
10 of the Robertsons and their company, Duck Commander, Inc.

11 15. The *Duck Dynasty* shows have become the most-watched shows in the history of the
12 A&E television network, and the season-four premiere of the show on August 14, 2013
13 drew a total of 11.8 million viewers making it the most watched nonfiction series
14 telecast in cable television history.

15 16. The members of the Robertson family of DUCK COMMANDER were recently
16 identified by Barbara Walters as among the “10 Most Fascinating People of 2013,”
17 along with Pope Francis, and will be appearing on Ms. Walters’ annual special on ABC
18 on December 18, 2013. According to Yahoo, and as evidence of their popularity, the
19 Robertson men of DUCK COMMANDER were the most searched costume idea for
20 Halloween in 2013. The Robertsons also appeared in the 2013 Macy’s Thanksgiving
21 Day Parade.

22 17. The Robertsons of DUCK COMMANDER have also been featured in numerous other
23 media outlets, appearing on television on *Conan*, *Tonight Show with Jay Leno*, *Late*
24 *Night with Jimmy Fallon*, *Live! with Kelly and Michael*, *Today*, *Katie*, *The Wendy*
25 *Williams Show* and *700 Club*, not to mention virtually every major television news
26 channel. The Robertsons of DUCK COMMANDER have also been featured in most
27 major newspapers, not to mention magazines such as *People*, *Us* and *Time*.

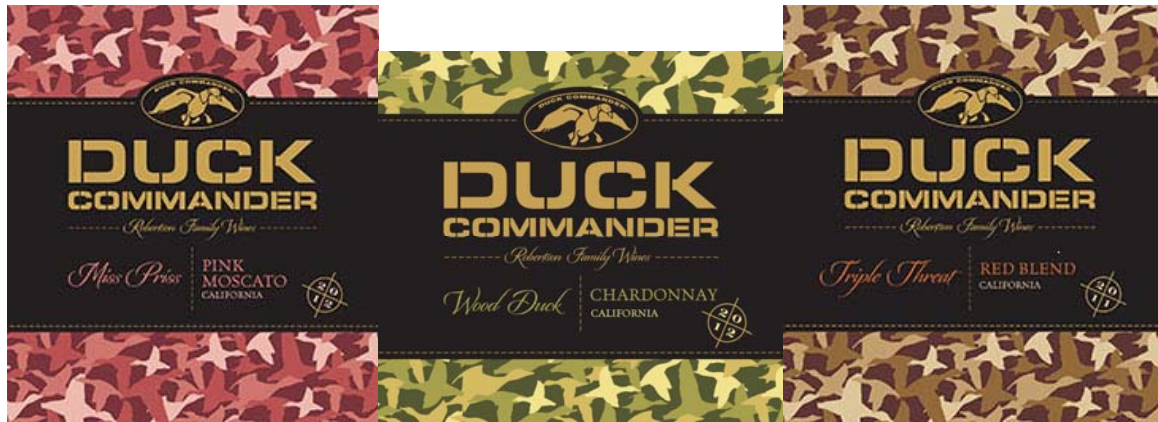
1 18. As a result of their fame and unique association with the DUCK COMMANDER
2 brand, the Robertsons, through DCI, have licensed use of the DUCK COMMANDER
3 brand on numerous goods including videos, books, clothing, coolers, thermo bottles,
4 cutting boards, aprons, platters, cookie jars, cups, water bottles, Christmas ornaments,
5 decals, key chains, fleece blankets, cologne, shower gel, balloons, bracelets, lanyards,
6 koozies, decals, posters, decorative tiles, license plates, seasonings and marinades.
7 Below is an image showing an example of such licensed products:



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15 19. In the Summer of 2013, DCI approached Plaintiff, Sutter Home Winery, Inc. ("SHW"),
16 owned by the Trinchero family, about the possibility of producing and distributing a
17 DUCK COMMANDER wine under license from DCI. As a family-owned winery,
18 SHW, like DCI, has multiple generations of the family working within the business.
19 The Trincheros believe that DCI and the Robertsons shared the same core values as the
20 Trincheros and SHW and on such basis moved forward to create a business relationship
21 whereby SHW would produce and sell DUCK COMMANDER wine under a trademark
22 license from DCI.

23 20. On July 25, 2013, DCI filed U.S. Trademark Application Serial No. 76/714,627 for the
24 mark DUCK COMMANDER and U.S. Trademark Application Serial No 76/714,615
25 for the mark DUCKMEN, both for wines based on intended use. Such applications
26 were approved by the U.S. Patent and Trademark Office and published for opposition
27 on October 1, 2013.

21. On September 30, 2013, SHW made its first shipment of DUCK COMMANDER wine under license from DCI. The first vintage of DUCK COMMANDER wine includes a Red Blend, a Chardonnay and a Pink Moscato. The DUCK COMMANDER wine is currently sold at retail for approximately \$10 per bottle. The labels for the DUCK COMMANDER wine are shown immediately below and feature a duck camouflage background with the DUCK COMMANDER word mark and logo, as well as the mark ROBERTSON FAMILY WINES:



22. The DUCK COMMANDER wines are marketed in association with the Robertson family. This is because it is the Robertson family and their DUCK COMMANDER brand that is appealing to the consumer. Below is an example of such marketing from the SHW website:

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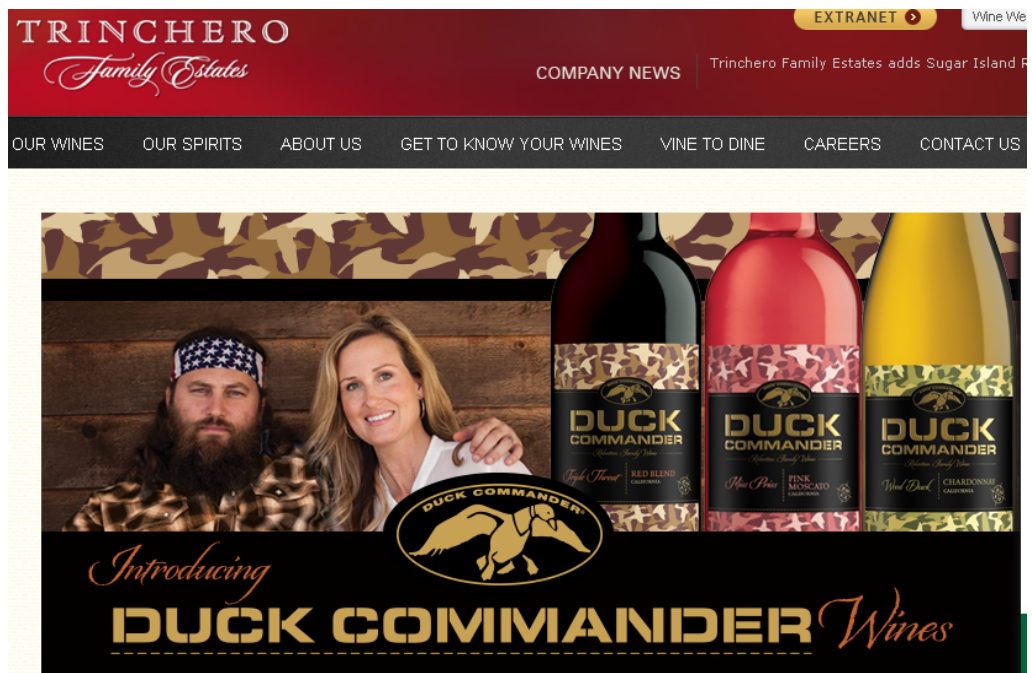
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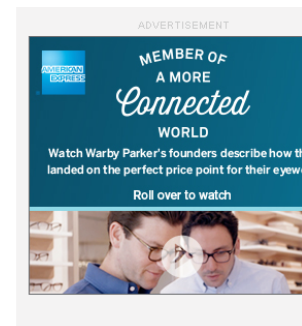


23. The media stories surrounding the release of the DUCK COMMANDER wine have also prominently featured the Robertson family and their association with the wine. Below is an excerpt from the story on the DUCK COMMANDER wine recently featured on People Magazine web site:

Hold On To Your Beards: 'Duck Dynasty' Wines Are Real

Originally posted 11/04/2013 05:34PM

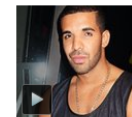
Share Tweet Google+ Stumble Pin it 8 Comments



You May Like...



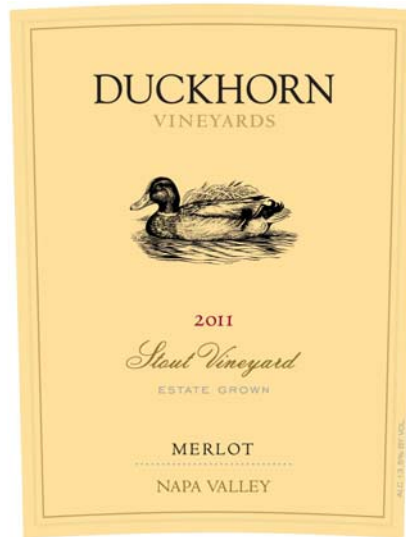
Buckle Up! It's the Craziest Reality Show Meltdowns



Heartbreak Drake's Highs and Lows

24. Counterdefendant is the owner of the registered trademarks DUCKHORN and DUCKHORN VINEYARDS for wine based on alleged first use of the marks in 1980.

Upon information and belief, the winery is named after the Duckhorn family which founded the winery. However, controlling interest in the winery was purchased by a private equity firm in 2007. According to Counterdefendant's web site, its wines sell at retail from \$29 - \$95 per bottle. The DUCKHORN label features a traditional beige background with the image of a duck floating on top of water and the DUCKHORN VINEYARDS word mark as shown below:



25. On October 29, 2013, Counterdefendant filed Notices of Opposition with the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office opposing DCI's trademark applications for DUCK COMMANDER and DUCKMEN, both for wine, claiming the marks are confusingly similar to the DUCKHORN mark.

26. Shortly thereafter, at Duckhorn's request, the principals of SHW, including Roger Trinchero and Bob Torres, met with Duckhorn President Alex Ryan on or about November 6, 2013 to listen to Duckhorn's objections to the DUCK COMMANDER mark based on Duckhorn's belief that the mark is confusingly similar to the DUCKHORN mark. SHW expressed its disagreement with Duckhorn's position and the meeting ended without any resolution.

27. On November 20, 2013, counsel for Duckhorn sent a demand letter to SHW in which he stated that “if you continue to ignore Duckhorn’s concerns and overtures, we will take legal action in the United States District Court for the Northern District of California to enforce Duckhorn’s longstanding federal trademark rights and to stop your infringing and unfair competitive activities.” The letter then demanded a response within twenty-four hours. A copy of this letter is attached hereto as Exhibit 1.

28. On November 22, 2013, both DCI and SHW responded to the demand letter advising Duckhorn that they would not cease use of the DUCK COMMANDER mark on wine as the mark is not confusingly similar to the DUCKHORN mark. Counterclaimants further emphasized that DUCKHORN does not have a monopoly in the term “duck” for wine. Counterclaimants also advised Counterdefendant that if it did not withdraw its threat of an infringement suit within five days Counterclaimants would initiate a declaratory judgment action. A copy of this letter is attached as Exhibit 2.

29. Not having heard from Counterdefendant as to its intentions by the requested deadline, Counterclaimants filed a complaint for declaratory relief against Counterdefendant on November 27, 2013. However, at the same time Counterdefendant was filing its Complaint for trademark infringement against Counterclaimants. As Counterdefendant’s action was first filed, Counterclaimants have dismissed their action and included their claim for declaratory judgment as counterclaim in this action.

30. As the Counterclaimants indicated in their November 22, 2013 letter to Counterdefendant, there are numerous marks encompassing the term “duck” registered by the U.S. Patent and Trademark Office for wine, including, without limitation, the following: LONG DUCK and Design (Reg. No. 4000279); SITTING DUCKS (Reg. No. 3923785); CHICKEN DUCK (Reg. No. 3739624); LUCKY DUCK (Reg. No. 4035432); DUCK TAPE (Reg. No. 3868228); DUCK DUCK GOOSE (Reg. No. 3710358); GREEN DUCK (Reg. No. 3699600); DUCKWORTH WINERY (Reg. No. 3283978); DUCK SHACK (Reg. No. 3545205); UGLY DUCKLING (Reg. No.

3320100); DUCK MUCK (Reg. No. 2855471); WILD DUCK CREEK ESTATE (Reg. No. 3069606); and, DUCK POND (Reg. No. 2374286). There are also several more marks encompassing the term “duck” for wine which have received notices of allowance from the U.S. Patent and Trademark Office, including the following: DUCK DOWN (App. No. 85760213); BANDED DUCK (App. No. 85673459); ORTHODUCKS (App. No. 85638644); and MAD DUCK (App. No. 85448175).

31. In addition to these “duck” marks for wine approved and registered by the U.S. Patent and Trademark Office, there are also numerous unregistered “duck” marks in use for wine which peacefully co-exist with Duckhorn’s DUCKHORN mark including the following: DUCK WALK; ONE TOE DUCK; DUCKLEBERRY GRUNT; JONTY’S DUCKS; BUTTERDUCKS WINERY; COLD DUCK; MOON DUCK; and DUCK CREEK RED.

32. DCI’s DUCK COMMANDER brand has wide market recognition, and Counterdefendant’s claim of likely consumer confusion between DCI’s DUCK COMMANDER mark and Counterdefendant’s DUCKHORN mark, has created a reasonable apprehension of liability for Counterclaimants and uncertainty for Counterclaimants in continuing to invest in the DUCK COMMANDER mark and develop the brand for wine, even if the Counterdefendant were to dismiss its infringement claims.

33. DCI’s DUCK COMMANDER mark and Counterdefendant’s DUCKHORN mark are not confusingly similar in the context of the nature of the goods on which they are used, the manner in which the marks appear on the goods in the marketplace, the marketing and distribution channels used for the respective goods, and due to the sophistication of the purchasers of the Counterdefendant’s products and the use by third parties of other marks on wine sharing features similar to both DCI’s and Counterdefendant’s respective marks.

CLAIM UNDER DECLARATORY JUDGMENT ACT

34. An actual controversy has arisen and now exists between the parties relating to Counterclaimants' ability to continue use of the DUCK COMMANDER trademark without incurring liability to Counterdefendant for infringement of its DUCKHORN trademark for which Counterclaimants desire a declaration of rights.

35. A declaratory judgment is necessary in that Counterclaimants contend, and Counterdefendant denies, that consumers are not likely to be confused between Plaintiff's use of the DUCK COMMANDER or DUCKMEN marks on wine and Counterdefendant's use of its DUCKHORN mark on wine.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays for a declaratory judgment against Counterdefendant as follows:

1. That the Court declare that there is no infringement of Counterdefendant's DUCKHORN mark by Counterclaimants' use of the DUCK COMMANDER or DUCKMEN marks or likelihood of consumer confusion between the parties' respective marks.
2. That the Commissioner for Trademarks at the U.S. Patent and Trademark Office be ordered to deny Opposition Nos. 91213217 and 91213212 filed against the applications for DUCK COMMANDER and DUCKMEN, respectively.
3. That Counterclaimants be awarded their costs, expenses and attorneys' fees incurred herein; and
4. For such other and further relief that the Court deems just and proper.

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1 Dated: 12/18/13

2 Respectfully submitted,

3
4 DICKENSON, PEATMAN & FOGARTY

5
6 By 

J. Scott Gerien
John N. Heffner

7 1455 First Street, Ste. 301
8 Napa, California 94559
9 Telephone: 707-252-7122
Facsimile: 707-255-6876

10 Attorneys for Defendants & Counterclaimants,
11 DUCK COMMANDER, INC., AND
12 SUTTER HOME WINERY, INC.

DICKENSON PEATMAN & FOGARTY

DEMAND FOR JURY TRIAL

Defendants and Counterclaimants hereby request a trial by jury in this matter.

Dated: December 18, 2013

Respectfully submitted,

DICKENSON, PEATMAN & FOGARTY

By

J. Scott Gerien
John N. Heffner

1455 First Street, Ste. 301
Napa, California 94559
Telephone: 707-252-7122
Facsimile: 707-255-6876

Attorneys for Defendants & Counterclaimants,
DUCK COMMANDER, INC., AND
SUTTER HOME WINERY, INC.

DICKENSON PEATMAN & FOGARTY